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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,187	02/06/2001	Peter Robert Baum	2873-US-CIP	9057

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IMMUNEX CORPORATION
LAW DEPARTMENT
1201 AMGEN COURT WEST
SEATTLE, WA 98119

EXAMINER

OUSPENSKI, ILIA I

ART UNIT	PAPER NUMBER
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1644

MAIL DATE	DELIVERY MODE
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12/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/778,187	Applicant(s) BAUM ET AL.	
	Examiner ILIA OUSPENSKI	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 22-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment and remarks, filed on 10/15/2007, are acknowledged.

Claims 1 – 19 and 35 – 63 have been cancelled.

Claims 20 – 34 are pending.

2. The rejections of record can be found in the previous Office Action, mailed on 06/18/2007.

The rejections of record have been withdrawn in view of Applicant's amendment and arguments, except as set forth herein.

3. The following is a quotation of the appropriate paragraphs of **35 U.S.C. 102** that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 22 – 34 stand rejected under **35 U.S.C. 102(e)** as being anticipated by Filvaroff et al. (US Patent No. 6,642,360; of record; see entire document), for the reasons of record.

Applicant's arguments have been fully considered but have not been found sufficiently convincing, as they apply to claims 22 – 34, as presently amended.

Applicant argues that the claims have been amended to address the outstanding rejection.

In response, it is noted that Applicant's Declaration under 37 CFR 1.131 by Drs. Baum and Fanslow, filed on 05/18/2005, while sufficient to overcome the rejection of record as it applies to claims 20 and 21, as presently amended, is deemed to be ineffective to overcome the rejection as it applies to claims 22 – 34, for the following reasons.

Applicant's Declaration is not sufficient in scope of disclosure, relative to the scope of the instant claims and the scope of teachings in the prior art.

As addressed in the previous Office Action, Filvaroff et al. teach an isolated polypeptide PRO355 (SEQ ID NO:61) (see entire document, in particular, e.g. the Sequence Listing, Figure 24, and column 13), which is 100% identical to the instant polypeptide of SEQ ID NO:2 from position 39 to position 442, and to the instant polypeptide of SEQ ID NO:4 from position 8 to position 423. Further, Filvaroff et al. teach fragments of the polypeptide, wherein the polypeptide is truncated at the amino-terminus or carboxy-terminus (e.g. columns 59 – 60, bridging paragraph). Filvaroff et al. also teach the polypeptide containing deletions of about 1 to 5 amino acids (e.g. column 59, lines 60 – 61). One of skill in the art is aware a truncation is a form of deletion; therefore, the skilled artisan would understand that Filvaroff et al. teach fragments of an isolated polypeptide PRO355, wherein said fragment has 1 to 5 amino acids removed from the amino-terminus or carboxy-terminus of the polypeptide sequence.

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Thus both the teachings of the prior art and the instant claims encompass in their breadth fragments of the recited polypeptides, wherein said fragments have 1 to 5 amino acids removed from the amino-terminus or carboxy-terminus of the polypeptide sequence. However, the Declaration is limited in scope to the sequence of human LDCAM of SEQ ID NO:2. As such, the Declaration is insufficient in scope to overcome the teachings of the prior art reference of Filvaroff et al. See MPEP §§715.02 and 715.03.

Therefore, the rejection of record is maintained for the reasons of record, as it applies to the amended claims. The rejection of record is incorporated by reference herein, as if reiterated in full.

4. Conclusion: claims 20 and 21 are allowable.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in cursive script that reads "Ilia Ouspenski". The signature is written in black ink and is positioned above the printed name and title.

ILIA OUSPENSKI, Ph.D.

Patent Examiner

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December 13, 2007